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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT TACOMA

NEWTECH TOUCH-UP SYSTEMS, INC.,

Case No. C09-5158RBL

Plaintiff,

MARKMAN CLAIM CONSTRUCTION
RULING

v.

FRONT LINE READY GA LLC, et al.,

Defendant.

This matter is before the court following a claims construction hearing pursuant to *Markman v. Westview Instruments, Inc.* 517 U.S. 370 (1996). The parties seek construction of certain claims of U.S. Pat. No. 7,320,811 (the '811 patent). The court has reviewed the materials and heard argument of counsel. The court's construction of this Patent's claims is set forth below.

A. Introduction.

Plaintiff is the assignee of the '811 Patent, which is entitled "Method and System for Paint Matching and Re-Touching." The patent relates to a process for applying "touch up paint" to scratches on vehicle paint. Acknowledging that there are many such products and processes in the market designed to accomplish this task, the '811 Patent was based on specific steps and materials, including most importantly for purposes of this Order, the use of four "cloths" to apply the materials in a series of steps. Defendants (former licensees of the '811 Patent) market a competing auto paint repair kit. Plaintiff contends that Defendants' competing product infringes on the '811 Patent.

1 At issue in this claims construction is the meaning of the term “cloth” as it is used in the ‘811 Patent.
 2 Defendants ask the court to construe the term narrowly, and Plaintiff seeks a broad construction. The parties
 3 agree on the construction of five other terms used in the ‘811 Patent, and the Court adopts the construction
 4 of those terms. [See Dkt. #29].

5 **B. The ‘811 Patent.**

6 The Doyle brothers invented their auto paint repair method in 2002. They began practicing it and
 7 applied for a Patent. After an Amendment, the ‘811 Patent was issued in 2008. [See Dkt. #33 at Exs. A and
 8 B]. Plaintiff Newtech is the assignee of the ‘811 Patent. The ‘811 Patent contains 6 claims, and the parties
 9 agree on the construction of five of these claim terms: solvent, dissolve, mixture, naptha, and drying additive.
 10 The parties’ disagreement centers on the use of the sixth term, “cloths.”

11 The ‘811 Patent claims are fairly straightforward. The Patent claims “an improvement to a method
 12 for using a paint cloth to apply touch-up paint[.]” It involves using “a paint cloth” to apply a solution
 13 containing solvent to the painted surface, “wherein the solvent is applied to a first cloth and then to the
 14 painted surface by rubbing the first cloth on the painted surface.” The ‘811 Patent then describes applying
 15 a mixture including wax and solvent to dissolve the portion of the paint and to produce a residue, “further
 16 wherein applying the mixture includes applying the mixture to a second cloth,” and describes the time and
 17 temperatures required for completing this step.

18 The third claimed step is “removing the residue including wax and the dissolved paint from the
 19 painted surface,” which includes “wiping the painted surface with a third cloth.” Each of these steps is
 20 contained in Claim 1. The final step, outlined in Dependent Claim 4, is “wiping the painted surface with a
 21 fourth cloth.” Dependent Claim 5 is “the method of Claim 4 wherein the fourth cloth is a micro fiber towel.”
 22 [Dkt. #33 at Ex. A].

23 The textual Description and Preferred Embodiment specification of the ‘811 Patent describes the use
 24 of “a first cloth, such as a towel.” Preferably, the technician applies the paint to “a second cloth, such as a
 25 section of shop towel. The section may, e.g., have a square area of about 3-inches by about 3-inches,
 26 although other sizes and materials may be used.” The touch-up point may then be applied to the painted
 27 surface by “rubbing the second cloth on the painted surface.” [Dkt. #33 at Ex. A].

28 The wax and solvent (naptha) mixture is then applied, preferably “to a third cloth, preferably a shop
 29 towel folded three ways[.]” At a given time (depending on environmental and other conditions) the technician

1 removes this residue, preferably “with a fourth¹ cloth, such as a white, terry cloth towel.” Finally the
 2 technician wipes the surface with a “fifth cloth, such as a micro fiber towel.” [Dkt. #33 at Ex. A].

3 **C. Standards for Claim Construction.**

4 It is well-settled that claim construction is a matter of law for the court. *Markman v. Westview*
 5 *Instruments, Inc.* 517 U.S. 370 (1996). In construing the language of a claim, the court primarily focuses
 6 on so-called “intrinsic evidence” which is comprised of “the patent itself, including the claims, the
 7 specification and, if in evidence, the prosecution history.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d
 8 1576, 1582 (Fed. Cir. 1996). Specifically, the court first looks to

9 the words of the claims themselves, both asserted and nonasserted, to define the scope of
 10 the patented invention. Although words in a claim are generally given their ordinary and
 11 customary meaning, a patentee may choose to be his own lexicographer and use terms in a
 manner other than their ordinary meaning, as long as the special definition of the term is
 clearly stated in the patent specification or file history.

12 *Id.* The court then reviews the specification to determine whether

13 the inventor has used any terms in a manner inconsistent with their ordinary meaning. The
 14 specification acts as a dictionary when it expressly defines terms used in the claims or
 15 when it defines terms by implication Thus, the specification is always highly relevant
 to the claim construction analysis. Usually, it is dispositive; it is the single best guide to
 the meaning of a disputed term.

16 *Id.* The court may then consider the prosecution history of the patent, if in evidence. This history
 17 contains the complete

18 record of all proceedings before the Patent and Trademark office, including any express
 19 representation made by the applicant regarding the scope of the claims. As such, the
 20 record before the Patent and Trademark Office is often of critical significance in
 determining the meaning of the claims. Included within an analysis of the file history may
 be an examination of the prior art cited therein.

21 *Id.* at 1582-83.

22 It is the court’s duty to resolve fundamental disputes among the parties as to the scope of a claim
 23 term, but it is not the court’s duty to construe every claim term, or to repeat or restate every claim term.

24 *See U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997); *02 Micro Int’l Ltd. v.*
 25 *Beyond Innovation Tech Corp.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008).

26 Ultimately, the interpretation to be given a term can only be determined and confirmed
 27 with a full understanding of what the inventors actually invented and intended to envelop

28 ¹This reference apparently predates the Patent’s Amendment, and the parties appear to agree that it
 refers to the third cloth described in the claims. This is also true of the subsequent reference to a fifth
 (actually fourth) cloth.

ORDER

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1 with the claim. The construction that stays true to the claim language and most naturally
 2 aligns with the patent's description of the invention will be, in the end, the correct
 3 construction.

4 *See Phillips v. AWH Corp.*, 415 F. 3d 1303, 1312 (Fed. Cir. 2005).

5 **D. Construction of Disputed Term(s).**

6 The parties disagree as to the scope and meaning of the term "cloth" as used in the '811 Patent.
 7 Plaintiff argues that only the term "cloth" requires construction, and that the court can and therefore
 8 should do so with reference to intrinsic evidence alone. Plaintiff advocates the following construction of
 9 the term "cloth:"

10 absorbent material suitable for holding in the hand and carrying out the identified purpose,
 11 i.e., applying paint, applying solvent, applying a mixture including a wax and a solvent,
 12 wiping the painted surface to remove residue, or wiping the painted surface after removing
 13 residue[.]

14 [See Dkt. #33 at p. 7].

15 Defendants argue that this construction is too broad, and would improperly include a variety of
 16 hand held absorbent items, including a sponge, a cotton ball, a nerf ball or a small cushion. Defendants
 17 advocate instead for the ordinary and customary construction of the term "cloth," meaning a "(1) material
 18 formed by knitting, pressing, or felting natural or synthetic fibers; (2) a piece of fabric or material used for
 19 a specific purpose." In the context of this dispute, they ask the Court to construe the term cloth as a
 20 towel or rag, specifically:

21 In the context of automotive detailing and paint repair, a cloth is a rag or a shop towel. In
 22 this context, a cloth or shop cloth cannot be a wad of cotton, a sponge, a paint brush, or an
 23 applicator with a sponge, rubber, cloth, or tip or end. It is limited to a rag or shop towel or
 24 auto detailing cloth.

25 [See Parties'Joint Claims Construction, Dkt. #33, Ex. 3].

26 Defendants emphasize that the '811 Patent clearly depends on, and claims only, the use of the
 27 various enumerated cloths, and seeks construction of each of these terms as a new and different cloth: "a
 28 paint cloth," "the first cloth , " "a second cloth," "a third cloth," and "a fourth cloth." They also ask the
 29 court to give construction to the *Jepson* format of the Plaintiff's patent claim, which is in the form of "an
 30 improvement to a method" for repairing paint scratches and chips. It argues that this is, as a matter of
 31 law, a concession that the subject matter of the preamble is the prior art of another. (*Citing In re Fout*, 675
 32 F.2d 297 (CCPA 1982)).

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2 Plaintiff's primary argument is that the term cloth as used in the '811 Patent is not and was not
3 intended to be exclusive, and that instead one skilled in the art would understand that the term meant any
4 of a variety of handheld, absorbent materials. In Plaintiff's view, the preferred embodiment (a cloth) is
5 only one of a number of such materials that could accomplish the given task, and its patent does not
6 disavow or restrict the term from meaning these materials.

7 Plaintiff also argues that the prosecution history of its patent supports its construction. It focuses
8 on the difference between the claims in its Patent and those disclosed in the prior art acknowledged in its
9 application, the "IMAC method." That method used a cotton swab or a Microbrush in one method, or a
10 cloth in the other. It argues that one skilled in the art, therefore, would understand that "cloth" is not
11 limited to particular types of cloth.

12 Finally, relying on the doctrine of claims differentiation, Plaintiff argues that the use of the term
13 "microfiber towel" in the fifth dependent claim supports the conclusion that the other cloths recited
14 should be construed to be broader, and include any type of absorbent, handheld material.

15 Defendants argue that the Plaintiffs's claims prove too much: First, they point out that every
16 reference to the term cloth in the '811 Patent involves a *towel*. [See Pl.s Opening Br., Dkt. #33 at 8;
17 compare Def.'s Response, Dkt. # 43 at 4]. It argues persuasively that plaintiff's attempts to infer from
18 "cloth" the meaning "or any handheld absorbent material" is contrary to the plain meaning of the term
19 and inconsistent with the Patent's claims and its prosecution history.

20 For example, Plaintiff argues that the reference to "shop towel" and "a 3 x 3 section" are
21 examples, using terms like 'such as' and "e.g.". Defendants again correctly point out that the examples
22 permit variance in the *type* of towel used, and the *size* of the towel used: "a second cloth, *such as a*
23 *section of shop towel*. The *section* may, e.g., have a square area of about 3-inches by about 3-inches,
24 although other sizes and materials may be used."

25 The '811 Patent's prosecution history similarly demonstrates that the use of a cloth (or four cloths)
26 was an important part of the Plaintiff's claim. It recognized that the previously patented IMAC system,
27 over which it sought a Patent, already sued a variety of handheld absorbent materials – including
28 Microbrushes, cotton swabs, sponges, and a section of thermal underwear – to apply the touch up paint in
various ways. If, as the Plaintiff now contends, the term cloth was intended to mean any handheld

1 absorbent material, it would necessarily include the methods used in the IMAC system; a system it was
2 seeking to “improve” upon in a manner that was entitled to patent protection.

3 As to claim differentiation, Plaintiff argues that the more specific use of the term “micro fiber
4 towel” in dependent claim 5 suggests and is consistent with a broader meaning of the term cloth in the
5 prior independent claims. But again this argument does not support a construction of the term “cloth” to
6 include any handheld absorbent material. Like the prior references to a terry cloth towel and to a shop rag,
7 the term is a specific type, or subset, of “cloth,” and its use does not suggest that the definition of cloth
8 should be expanded to include other handheld absorbent items which are not “cloths as that term is
9 commonly understood, or would be understood by one skilled in the art.

10 In short, nothing in the ‘811 Patent suggests anywhere that the claimed invention involves the use
11 of something other than a cloth, as that term is commonly used. Plaintiff’s broad construction is rejected
12 as too inclusive. The construction that stays true to the claim language and most naturally aligns with the
13 patent’s description of the invention will be, in the end, the correct construction. *See Phillips v. AWH*
14 *Corp.*, 415 F. 3d 1303, 1312 (Fed. Cir. 2005). The Defendant’s proposed construction of the term cloth
15 is, in the context of this patent and this dispute, correct, and the Court therefore ADOPTS this
16 construction:

17 In the context of automotive detailing and paint repair, a cloth is a rag or a shop
18 towel. In this context, a cloth or shop cloth cannot be a wad of cotton, a sponge, a paint
19 brush, or an applicator with a sponge, rubber, cloth, or tip or end. It is limited to a rag or
shop towel or auto detailing cloth.

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The other point in dispute is whether the specific cloths referenced in the ‘811 Patent should be
construed individually. Defendants argue that the ‘811 Patent’s reference to four different cloths should
be construed to mean that a new and different cloth is used in each step described. Plaintiff argues that
this is not so, and that a single, suitably large cloth could be used for each step. Plaintiff again ignores the
terms of its Patent, and the rules of construction. Defendants’ reliance on *Gillette v. Energizer Holdings*,

1 403 F.3d 1367 (Fed. Cir. 2005) is correct; the enumeration of four specific cloths in the '811 patent means
2 that four separate cloths are to be used to practice the claimed method.

3 IT IS SO ORDERED.
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5 DATED this 23rd day of December, 2010
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8 RONALD B. LEIGHTON
9 UNITED STATES DISTRICT JUDGE
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